

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Gerrit Luinstra et al.

Application No.: 10/523,263

Confirmation No.: 1826

Filed: March 7, 2005

Art Unit: 1626

For: CATALYST FOR THE CARBONYLATION
OF OXIRANES

Examiner: Rei Tsang Shiao

RESPONSE TO RESTRICTION/ELECTION REQUIREMENTS

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed April 10, 2007, applicant hereby provisionally elects claims Group II for continued examination, with traverse.

The Examiner has required restriction between:

Group I. Claims 1-8, drawn to processes of making lactones, wherein the starting material oxiranes is selected from ethylene oxide, propylene oxide, butylenes oxide, cyclopentene oxide, cyclohexene oxide; and

Group II. Claims 1-8, drawn to processes of making lactones, containing the starting material oxiranes compounds not encompassed in Group I.

Election

In response to the election requirement, the applicant elects Group I. Claims 1-8, drawn to processes of making lactones, wherein the starting material oxiranes is selected from ethylene oxide, propylene oxide, butylenes oxide, cyclopentene oxide, cyclohexene oxide.

For the single disclosed species, the applicant elects ethylene oxide or propylene oxide or a mixture thereof. Applicant's election is made without prejudice.

Applicants respectfully traverse the Restriction requirement because the U.S. Patent and Trademark Office has not carried forward its burden of proof to establish distinctness.

In particular, MPEP § 803 states:

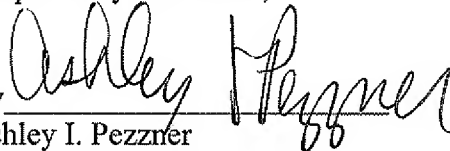
If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Accordingly, Applicants respectfully traverse the outstanding Election requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

As noted by the Examiner, upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to not more than a reasonable number of species in addition to the elected species, provided that all claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.146. For the above reasons, this restriction requirement should be withdrawn.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 13156-00001-US from which the undersigned is authorized to draw.

Respectfully submitted,

By 

Ashley I. Pezzner

Registration No.: 35,646

CONNOLLY BOVE LODGE & HUTZ LLP

1007 North Orange Street

P.O. Box 2207

Wilmington, Delaware 19899

(302) 658-9141

(302) 658-5614 (Fax)

Attorney for Applicant